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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/618,755	07/15/2003	Lee W. Johnston	53394.000712	6941
21967	7590	11/02/2004	EXAMINER	
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			CHAPMAN, GINGER T	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/618,755

**Applicant(s)**

JOHNSTON ET AL.

**Examiner**

Ginger T Chapman

**Art Unit**

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/15/03 & 9/16/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### *Claim Language*

Claims 15 and 33, line 2: "650 to about 1350 g/cm<sup>2</sup>" should be replaced by "650 to about 1350 gsm" ("grams per square meter") in accordance with specification, page 32.

### *Claim Rejections - 35 USC § 102/103*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-14, 16-21, 23-32, 34-49 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,646,180 issued to Chmielewski.

When viewing the claimed invention the limitations drawn to test results, i.e. "thermal resistance of less than about 1.7 watts/m<sup>2</sup> as measured in a Thermolab apparatus," are being considered as product-by-process limitations. Accordingly § 2113 of the MPEP, some of which is reproduced below, dictates the manner in which the claims have been examined. Since the

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product can only be understood by finding the result of certain claimed characteristics, which are the result of tests, the burden of proof to overcome any rejection must be shifted to the applicant.

“The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature” than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

The MPEP further states that the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive

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structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979).

Chmielewski discloses the same materials that applicant has indicated are used in the absorbent core of the article. In as much, the teachings of Chmielewski provide all that is claimed in the instant application. In the alternative, it would have been obvious to have provided the material that meets the required test characteristics since applicant has not provided any most favorable product for use in the article or provided any proof that one of the many possible products is required to make the invention operable.

“[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.” *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

As depicted in Figures 1 and 2, Chmielewski discloses an absorbent article having a topsheet (30), a backsheet (32), an absorbent core (342) disposed therebetween, wherein the topsheet and backsheet form a first waist region (22), a second waist region (24) and a crotch

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region (26) and further having a fastening element (40) with corresponding target device (401) capable of attaching to one another are attached to the laterally extending edges of first and second waist regions respectively. The absorbent article includes elastic leg gathers (36) disposed adjacent to the crotch region (col. 11, line 14) and a pair of standing leg gathers (501, 502), also known in the diaper art as waste containment flaps (applicant specification, page 11).

Chmielewski further discloses a C-folded (col. 5, line 21) absorbent core (342) having an upper layer (342b), a lower layer (342c) and a central fibrous layer (342a) disposed between the upper and lower layer.

The central fibrous layer includes a mixture of fibrous material and superabsorbent polymer (SAP) wherein the SAP is from the class of crosslinked sodium-neutralized polyacrylates which includes starch grafted polyacrylate sodium salt (col. 1, line 44); the fibrous material is a crimped tow of cellulose acetate (col. 23, line 8) or polyester, or selected from a group including low-density roll good or carded web (col. 23, lines 9-12). The central fibrous layer is about 50-95% by weight SAP and has a SAP efficiency of at least 80% (col. 7, lines 18-27). The core has a density within the range of 0.10-0.40g/cm<sup>3</sup> (col. 5, line 9) and further includes 1-10% preferably 5% of a thermally bonded fiber (col. 19, lines 48-49). The central fibrous layer additionally includes water insoluble hydrophilic polymer additives with particle diameters less than 100μm (col. 10, line 17); the preferred particulate additives are selected from the group consisting of potato, corn, wheat, and rice starches and partially cooked or modified starches (col. 10, lines 24-34).

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Claims 7-12, 22, 15 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chmielewski ('180) as applied to claim 1 above, and further in view of U.S. Patent No. 6,068,620 issued to Chmielewski (hereinafter '620).

Chmielewski ('180) discloses that a variety of optional fluid transfer, spreading and acquisition layers may be included between the absorbent core and topsheet and backsheet layers to direct or wick the flow of liquid in the article (col. 15, lines 46-51). Chmielewski ('180) fails to elaborate further; however, Chmielewski ('620) teaches that it is known to utilize additional optional layers for acquisition and distribution of fluids (col. 9, line 39) and for storage of fluids (col. 9, line 40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the optional layers of Chmielewski ('180) to facilitate the transfer and storage of fluid in the absorbent article as taught by Chmielewski ('620) for the purpose of reducing leakage from the diaper before all of the absorbent material is fully saturated.

With regard to claims 15, 22 and 33, Chmielewski ('180) discloses all aspects of the claimed invention but is silent as to the total basis weight and thickness of the absorbent core. As depicted in figs 2, 3, and 4 Chmielewski ('620) teaches a core wherein the combined basis weights of layers is in the range 300-1400gsm (col. 11, lines 30-37; col. 12, lines 44-51). It is well known in the diaper art to vary the size, absorbent capacity and basis weights of the core in order to accommodate the size of the intended wearer and the volume of liquid loading imparted by the intended use of the article. It would therefore be obvious to one having ordinary skill in the art at the time the invention was made to adjust the basis weights and thickness of the core layers of Chmielewski ('180) as taught by Chmielewski ('620) to provide a variety of sizes and

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absorbent capacities for the varying needs of the wearer of the article since the provision of size adjustability involves only routine skill in the art.

Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chmielewski ('180) as applied to claim 1 above, and further in view of U.S. Patent No. 6,238,379 issued to Kuehn, Jr et al.

With regard to claim 4, Chmielewski ('180) teaches a fastening system (40) utilizing tape or other suitable mechanical fasteners. Chmielewski is silent as to employing hook and loop fasteners to secure the article about the waist of the wearer. It is well known in the diaper art that mechanical type fasteners include, inter alia, hooks and loops, tapes, adhesives, cohesives, safety pins, buttons and snaps. Kuehn et al disclose the use of mechanical fastening means. In particular, Kuehn teaches that it is generally known in the art to employ hook and loop fasteners to secure a diaper on the wearer (col. 9, lines 46-50) because hook and loop type fasteners are capable of being released and reattached. Therefore, to have utilized the hook and loop type mechanical fastener as taught by Kuehn in the Chmielewski mechanical fastening system to produce a diaper that can be adjusted or checked for soiling without compromising the ability to reuse the fastener would have been obvious to one of ordinary skill in the art at the time the invention was made.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,545,195 issued to Chmielewski discloses absorbent articles having cores utilizing fibrous liquid acquisition/distribution layers and high internal phase emulsion



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(HIPE) fluid storage/redistribution layers. U.S. Statutory Invention Registration No. H1969 to Fell et al discloses breathable absorbent garments incorporating microporous film layers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T Chapman whose telephone number is (703) 305-0471. The examiner can normally be reached on Monday through Friday 8:30 a.m. to 5:00 p.m..

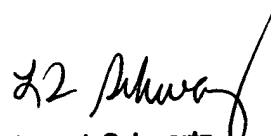
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (703) 308-1412. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ginger Chapman  
Patent Examiner, Art Unit 3761



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Larry I. Schwartz  
Supervisory Patent Examiner  
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